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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/526,999

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Yuichiro Sasaki

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RATNERPRESTIA
P.O. BOX 980
VALLEY FORGE, PA 19482

EXAMINER

SARKAR, ASOK K

ART UNIT

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/526,999	Applicant(s) SASAKI ET AL.	
	Examiner Asok K. Sarkar	Art Unit 2891	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-14,16,17,34 and 38-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,5-14 and 16 is/are allowed.
- 6) ☒ Claim(s) 17,34 and 38-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 17, 34 and 38 – 50 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 17, 34, 38, 39, 43 – 47, 49 and 50 are rejected under 35 U.S.C. 102(b) as being anticipated by Mizuno, US 5,851,906.
4. Regarding claims 17, 34 and 38, Mizuno teaches a method of introducing impurity; wherein,

- in the course of introducing a material to a solid substance (see the Title) which has an oxidized film or other film sticking on the surface, the oxidized film and other film are first removed as the surface treatment to the solid substance in column 1, lines 15 – 20 and in column 3, lines 47 – 67, and
- a certain desired particle is attached or introduced in column 4, lines 4 – 23.

These are product by process claims. Note that a “product by process” claim is directed to the product per se, no matter how actually made, *In re Hirao*, 190 USPQ 15 at 17 (footnote 3). See also *In re Brown*, 173 USPQ 685; *In re Luck*, 177 USPQ 523; *In re Fessmann*, 180 USPQ 324; *In re Avery*, 186 USPQ 161; *In re Wertheim*, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); *In re Marosi et al*, 218 USPQ 289; and particularly *In re Thorpe*, 227 USPQ 964, all of which make it clear that it is the patentability of the final product per se which must be determined in a “product by

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process” claim, and not the patentability of the process, and that an old or obvious product produced by a new method is not patentable as a product, whether claimed in “product by process” claims or not. Note that applicant has the burden of proof in such cases, as the above case laws make clear.

Regarding claim 39, Mizuno teaches the certain desired particle is attached or introduced by bringing a gas containing the certain desired particle to make contact to the surface of solid substance which surface has been made to be free of the oxidized film and other film, thereby the particle is attached or introduced to the surface, or the vicinity, of solid substance as was described earlier in rejecting claim 34 and in column 4, lines 4 – 23.

Regarding claim 43, Mizuno teaches the attaching or introducing of certain desired particle is conducted in an environment in which the temperature of solid substance is lower than 600 °C in column 4, lines 22 – 23.

Regarding claims 44, 45 and 50, Mizuno teaches a method of introducing impurity; wherein, in the course of introducing a material in the phase of ion, plasma, gas, etc. to a solid substance which has an oxidized film or other film sticking to the surface, the oxidized film and other film are first removed as the surface treatment to solid substance a means for dipping the surface of solid substance in a reductive liquid, and then a certain desired particle is attached or introduced as was described earlier in rejecting claim 34.

These are product by process claims. Note that a “product by process” claim is directed to the product per se, no matter how actually made, *In re Hirao*, 190 USPQ 15 at 17 (footnote 3). See also *In re Brown*, 173 USPQ 685; *In re Luck*, 177 USPQ 523; *In re Fessmann*, 180 USPQ 324; *In re Avery*, 186 USPQ 161; *In re Wertheim*, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); *In re Marosi et al*, 218 USPQ 289; and particularly *In re Thorpe*, 227 USPQ 964, all of which make it clear that it is the

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patentability of the final product per se which must be determined in a “product by process” claim, and not the patentability of the process, and that an old or obvious product produced by a new method is not patentable as a product, whether claimed in “product by process” claims or not. Note that applicant has the burden of proof in such cases, as the above case laws make clear.

Regarding claims 46, 47 and 49, Mizuno teaches at least one facility selected from among each of the following respective categories is used; at least one apparatus selected from among the group consisting of an apparatus for irradiating the surface of solid substance with plasma, an apparatus for irradiating the surface of solid substance with gas and an apparatus for dipping the surface of solid substance in a reductive liquid; an apparatus for bringing a gas containing a certain desired particle to the surface of solid substance; and an annealing apparatus for diffusing the certain desired particle attached or introduced therein with reference to Fig. 1 and in between column 3, line 34 and column 4, line 56.

Claim 47 is a product by process claims. Note that a “product by process” claim is directed to the product per se, no matter how actually made, *In re Hirao*, 190 USPQ 15 at 17 (footnote 3). See also *In re Brown*, 173 USPQ 685; *In re Luck*, 177 USPQ 523; *In re Fessmann*, 180 USPQ 324; *In re Avery*, 186 USPQ 161; *In re Wertheim*, 191 USPQ 90 (209 USPQ 554 does not deal with this issue); *In re Marosi et al*, 218 USPQ 289; and particularly *In re Thorpe*, 227 USPQ 964, all of which make it clear that it is the patentability of the final product per se which must be determined in a “product by process” claim, and not the patentability of the process, and that an old or obvious product produced by a new method is not patentable as a product, whether claimed in “product by process” claims or not. Note that applicant has the burden of proof in such cases, as the above case laws make clear.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 40 – 42 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mizuno, US 5,851,906 in view of NTT Corp., JP 07094427 (English Abstract and Translation).

Regarding claims 40 and 48, Mizuno fails to teach the method of attaching or introducing a certain desired particle is irradiating the surface of solid substance, which surface has been made to be free of the oxidized film and other film, with

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electromagnetic wave whose energy is matching the energy that is binding the hydrogen or hydroxyl radical sticking on the surface with the atom of solid substance, thereby converting the binding into a non - coupled state, separating the sticking hydrogen or hydroxyl radical, and exposing the atom constituting solid substance to the surface; and then introducing the certain desired particle for making contact so that the particle is attached or introduced to the surface, or the vicinity, of solid substance.

NTT Corp teaches a method of doping in which the surface of solid substance is irradiated with an electromagnetic wave at an energy that is more than the ionization energy of the doping gas (see the English Abstract). This energy should be sufficient to separate the sticking hydrogen or hydroxyl radical from the oxide removal process, and expose the atom constituting solid substance to the surface so that the particle is attached or introduced to the surface, or the vicinity, of solid substance after making the contact with the surface for the benefit of doping at low temperature of 400 °C or less (see the Advantage in the English Abstract, also paragraph 9 of the English translation).

Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention to modify Mizuno and irradiate the surface of solid substance, which surface has been made to be free of the oxidized film and other film, with electromagnetic wave whose energy matches the energy that is binding the hydrogen or hydroxyl radical sticking on the surface with the atom of solid substance, thereby converting the binding into a non – coupled state, separating the sticking hydrogen or hydroxyl radical, and exposing the atom constituting solid substance to the surface; and then introducing the certain desired particle for making contact so that the particle is

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attached or introduced to the surface, or the vicinity, of solid substance for the benefit of doping at low temperature of 400 °C or less as taught by NTT Corp in the Advantage portion of the English Abstract and in paragraph 9 of the English translation.

Regarding claims 41 and 42, Mizuno in view of NTT Corp. fails to teach the energy of irradiating electromagnetic wave is between 318 kJ/mol and 666 kJ/mol.

However, it would have been obvious to one with ordinary skill in the art at the time of the invention to judiciously adjust and control these parameters during the doping process of the NTT Corp. through routine experimentation and optimization to achieve optimum benefits (see MPEP 2144.05) and it would not yield any unexpected results.

Note that the specification contains no disclosure of either the critical nature of the claimed processes or any unexpected results arising therefrom. Where patentability is said to be based upon particular chosen methods or upon another variable recited in a claim, the Applicant must show that the chosen methods or variables are critical (Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934, 1936 (Fed. Cir., 1990)). See also In re Aller, Lacey and Hall (10 USPQ 233 – 237).

Allowable Subject Matter

9. Claims 1, 5 – 14 and 16 are allowed.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asok K. Sarkar whose telephone number is 571 272 1970. The examiner can normally be reached on Monday - Friday (9 AM- 6 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sue A. Purvis can be reached on 571 272 1236. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Asok K. Sarkar/
Primary Examiner, Art Unit 2891
October 31, 2008